

REMARKS

Claims 36-39, 44 and 57-59 are pending. By this Amendment, independent claims 36 and 44 are amended to even further distinguish over the applied references, claim 39 is amended for clarity, dependent claims 57-59 are added, and claims 45-47 and 53-56 are canceled without prejudice to or disclaimer of the subject matter recited therein. Support for the amendments to claims 36 and 44 and for the features recited in new claims 58 and 59 can be found throughout the specification. See, for example, page 3, lines 5-13. Moreover, the digital image data taken by a camera and the data of a visual broadcast program are different and come from different sources as described throughout the specification. Regarding new dependent claim 57, see, for example, page 24, lines 10-17. Thus, no new matter is added by the above amendments.

Claims 45, 46, 54 and 56 stand rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,266,483 (Okada et al.). In addition, claims 47, 53 and 55 stand rejected under 35 U.S.C. §103(a) over Okada et al. The rejections are moot in view of the cancellation of claims 45-47 and 53-56.

Claims 36-38 and 44 stand rejected under 35 U.S.C. §103(a) over Okada et al. in view of JP-A-10-129082 (Fumio). The rejection is respectfully traversed.

Applicant respectfully submits that the Office Action has failed to establish a *prima facie* obviousness rejection with respect to independent claims 36 and 44 (along with their dependent claims). The Office Action relies upon impermissible hindsight in combining the references to reject Applicant's claims.

The Office Action recognizes that Okada et al. fails to disclose the claim 36 controller "that controls the recording circuit to interrupt the recording of the digital image data, when recording instructions of the visual broadcast program are detected during the recording of the digital image data" and fails to disclose the claim 44 controller "that controls the playback

circuit to interrupt the playback of the digital image data, when playback instructions of the visual broadcast program are detected during the playback of the digital image data." In fact, Okada et al. fails to even appreciate that the situation could exist in which recording or playback instructions of a visual broadcast program are detected during the recording or playback of digital image data. Thus, Okada et al. provides no reason/motivation for the modifications proposed in the Office Action. Okada et al. does not recognize the existence of or propose any solution to the "conflict resolution" problem mentioned in the last line on page 7 of the Office Action.

The additional references cited in the Office Action do not suggest modifying Okada et al. to result in the combinations of features recited in independent claims 36 and 44. The additional references do not recognize or address any "conflict resolution" problem involving the recording or playback of digital image data and data of a visual broadcast program. Accordingly, the additional references do not suggest modifying Okada et al. to result in the combinations of features recited in Applicant's independent claims 36 and 44.

The Office Action cites US 2001/0016108 (Itoh et al.) to support its "official notice that it was well known at the time of the invention to assign priorities for recording select broadcast programs" However, Itoh et al. does not involve assigning priorities for recording select broadcast programs. Moreover, Itoh et al. does not involve the resolution of any conflict between the recording or playback of digital image data received from a camera and data of a visual broadcast program. Itoh et al. relates to an apparatus/method in which the creation of a thumbnail image from moving image data is interrupted if another moving image is to be recorded. Itoh et al. does not relate to recording or playback of a video broadcast program. Accordingly, Itoh et al. does not suggest modifying the system of Okada et al. to result in the combination of features recited in Applicant's claims, and Itoh et al. does

not support the Office Action's "official notice" assertion "that it was well known at the time of the invention to assign priorities for recording select broadcast programs."

To even further distinguish the claims from Itoh et al., independent claims 36 and 44 have been amended to further clarify that the data of the visual broadcast program is different from the digital image data. In Itoh et al., the data of the thumbnail image is the same as the moving video data. Furthermore, dependent claims 58 and 59 have been added, and recite that "a source of the digital image data is different from and independent of a source of the data of the visual broadcast program." The thumbnail image generated by Itoh et al. is generated from the moving video data, and does not have a source that is different from and independent of a source of the moving video data.

As discussed in Applicant's previous response, Fumio also does not provide any motivation or reason to modify Okada et al. to result in the combination of features recited in independent claims 36 and 44. Fumio relates to printing, not recording of data in a storage or playback of data from a storage. See paragraphs [0028] - [0031] of Fumio. Thus, the "recording" of Fumio referenced in the Office Action is printing, not recording of data in a storage or playback of data from a storage. Fumio ensures that sufficient paper exists for a higher priority print job by printing the higher priority print job if sufficient paper would not be present to print that job and other lower priority jobs. Fumio provides no reason to modify the system of Okada et al. to result in the controller of Applicant's independent claims 36 and 44.

Moreover, the Office Action continues to fail to address the claim 44 features which relate to playback, not recording. Thus, the Office Action fails to address all features of independent claim 44.

Withdrawal of the rejection is requested.

Claim 39 stands rejected under 35 U.S.C. §103(a) over Okada et al. in view of Fumio, and further in view of WO 92/022983 (Browne). The rejection is respectfully traversed.

Browne does not overcome the deficiencies noted above with respect to the rejection of claim 36, from which claim 39 depends. Accordingly, claim 39 also is patentable. Withdrawal of the rejection is requested.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe anything further would be desirable to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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MAC/axl

Attachment:

Request for Continued Examination

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